

REMARKS/ARGUMENTS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 1-21 remain pending in this application. Claim 1 has been amended in this Response.

Anticipation under Section 102 of the Patent Act requires that a prior art reference disclose every claim element of the claimed invention. See, e.g., Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1574 (Fed. Cir. 1986). While other references may be used to interpret an allegedly anticipating reference, anticipation must be found in a single reference. See, e.g., Studiengesellschaft Kohle, G.m.b.H. v. Dart Indus., Inc., 726 F.2d 724, 726-27 (Fed. Cir. 1984). The absence of any element of the claim from the cited reference negates anticipation. See, e.g., Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 715 (Fed. Cir. 1984). Anticipation is not shown even if the differences between the claims and the prior art reference are insubstantial and the missing elements could be supplied by the knowledge of one skilled in the art. See, e.g., Structural Rubber Prods., 749 F.2d at 716-17.

The Examiner rejected Claim 1 under 35 USC 102(b) as anticipated by Bostad. The Applicants respectfully request reconsideration of this rejection for the reasons set out below.

Claim 1 is directed to a side shift frame with a lower cross member which defines a sliding surface adapted to permit fork positioning. Specifically, the sliding surface permits fork positioning such that the shank portion of the fork is located no further forward than the front face of the upper cross member of the side shift frame. In contrast, Bostad discloses only an apparatus capable of side shifting. Bostad does not include any disclosure relating to fork positioning.

In addition, Claim 1 is directed to an assembly in which the side shift operator means is slidably received within a portion of the frame support member. Claim 1 has been amended to recite this limitation more clearly. The side shift operator means of Bostad (referred to as hydraulic cylinder 52) is located outside the frame support member (referred to as upper cross bar 44) and is completely exposed (see Fig. 1 and, in particular, Fig. 2). It is clearly not received within any portion of the frame support member.

In view of the foregoing distinctions, the Applicants respectfully submit that Claim 1 is not anticipated by Bostad. Because claims 2-13 depend from an allowable base claim, the Applicants respectfully submit that these claims are also allowable.

Claims 14-20 were rejected under 35 USC 103(a) as obvious over Bostad in view of Shinoda. The Applicants respectfully request reconsideration of this rejection for the reasons set out below.

Claim 14 is also directed to a side shift assembly in which the side shift operator means is slidably received within a portion of the frame support member. As discussed above, Bostad does not meet this limitation. Shinoda discloses a side shifter where the side shift means (referred to as shift cylinder 90) is exposed (see Fig. 34), rather than being received in a portion of the frame support member, as claimed in Claim 14. Thus, Shinoda does not overcome the deficiencies of Bostad with respect to the claimed invention. Accordingly, neither Bostad nor Shinoda, alone or in combination, disclose all of the limitations recited in Claim 14.

In view of the above, the Applicants respectfully submit that Claim 14 is not obvious in view of the combination of Bostad and Shinoda. Because claims 15-20 depend from an allowable base claim, the Applicants respectfully submit that these claims are also allowable.

Claim 21 was rejected under 35 USC 103(a) as obvious over Bostad in view of DE 19805790 (Bolzoni). The Applicants respectfully request reconsideration of this rejection for the reasons set out below.

It is clear that the initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. In re Piasecki, 745 F. 2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to arrive at the claimed invention from the prior art. Ex parte Clapp, 227 USPQ 972 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp. 837 F.2d 1044, 7 USPQ 2d 1434 (Fed. Cir. 1988). Furthermore, Section 103 does not allow the Examiner to engage in picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. In re Wesslau, 147 USPQ 391 (CCPA 1975).

The side shift frame disclosed in Bostad includes two intermediate vertical supports (31) extending between upper and lower horizontal cross members (26, 28). These intermediate supports are located inwardly of vertical end members (30, 32). Any fork positioner would have to fit in between these two intermediate supports. The fork positioner disclosed in Bolzoni mounts within the side shift frame (see Figs. 4 and 6). The intermediate vertical supports of Bostad would preclude the Bolzoni fork positioner from being mounted into the side shift frame of Bostad. Even if the Bolzoni fork positioner was capable of being installed in the side shift frame of Bostad, it would not be effective because the range of fork positioning between the intermediate supports would be severely restricted.

Accordingly, the side shifter disclosed in Bostad cannot be combined with the fork positioner of Bolzoni without completely redesigning this side shifter to accept a fork positioner. The Applicants respectfully submit that such a redesign would not be obvious to a mechanic with ordinary skill in the art, without the benefit of applicants' disclosure.


Furthermore, even if the Bostad side shifter and Bolzoni fork positioner could be combined, neither reference alone or in combination would disclose all of the limitations of Claim 21. In this regard, claim 21 is directed to a combination side shifter and fork positioner where the shift means is located within a portion of the frame support member. As discussed above, Bostad does not disclose this limitation. Bolzoni also discloses a side shifter where the side shift means (identified by part number 37 in Fig. 3) is exposed, rather than being located in a portion of the frame support member, as claimed in Claim 14.

For all of the above reasons, the Applicants respectfully submit that Claim 21 is not obvious in view of the combination of Bostad and Bolzoni.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 
Michelle N. Lester
Reg. No. 32,331

MNL:slj
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100